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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,952	09/01/2006	Makoto Ouchi	125977	5274
25944 7590 12/03/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
LSTVOYB, GREGORY				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/577,952

**Applicant(s)**

OUCHI ET AL.

**Examiner**

GREGORY LISTVOYB

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 and 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/15/2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 10 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the new limitation of claim 1 "the one of said poly-L-lactic acid and poly-D-lactic acid is bonded to the lamellar clay mineral to the exclusion of the other of

said poly-L-lactic acid and said poly-D- lactic acid is not bonded to the lamellar clay mineral" does not have a sufficient support in the Specification.

Example 1 of the Specification simply discloses a mixture of bonded PLLA (L-poly(lactic acid)) and PDLA (D-poly(lactic acid)). However, Specification does not provide any evidence of exclusion of one type of poly(lactic acid) by another one.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The new limitation of claim 1 "the one of said poly-L-lactic acid and poly-D-lactic acid is bonded to the lamellar clay mineral to the exclusion of the other of said poly-L-lactic acid and said poly-D- lactic acid is not bonded to the lamellar clay mineral" is unclear.

Examiner does not understand the exact meaning of the word "exclusion" from the context of the claim. It is not clear whether Applicant mean exclusion from interlamellar space or exclusion from the entire composition.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuru et al (JP 2003-073538, cited in IDS) herein Mitsuru in combination with Yosimura (US 2005/0001349) herein Yosimura (necessitated by amendment) as evidences by EP 0288041.

Mitsuru discloses a polylactic acid resin composition characterized by comprising a polylactic acid-lamellar clay mineral bonded body consisting of a lamellar clay mineral and one of poly-L-lactic acid and poly-D-lactic acid (see line 0052), which is bonded to the lamellar clay mineral with onium salt having a hydroxyl group (see Abstract). Mitsuru does not explicitly teach the poly-L-lactic acid and poly-D-lactic acid which is not bonded to the lamellar clay mineral.

However, several factors point out to a suggestion that polylactic acid exists in the composition in both bounded and unbounded forms:

1. Mitsuru teaches that polylactic acid can be bounded only with its end group (see line 0009). Since molecular weight of the polymer can vary in a very broad range (5000-1000000, see line 0016), subsequently dramatically change the concentration of reactive groups, it is expected that some of end groups remain unreacted;

2. Mitsuru discloses a broad concentration range of onium salt (see line 0023) and ratio between polylactic acid and onium salt (see line 0039), which leads to coexistence of bounded and unbounded forms of polylactic acid;

3. Mitsuru teaches that the distance between clay layers is more than 5 nm. This size (nm) is comparable with the size of the macromolecule. Therefore, some polylactic acid will not be able to penetrate between the layers to bind to the clay;

4. Mitsuru teaches two types of manufacturing processes (see line 0041). One of them comprises a procedure of mixing of onium-salt modified clay with polylactic acid. Second process discloses in situ synthesis of polylactic acid with the clay, meeting the limitations of Claim 10. At least for the first process the existence of both forms of polylactic acid is expected.

The position is taken that the coexistence of bounded and unbounded forms of polylactic acid is desirable, since it provide a better distribution of the resin between the clay layers. (Bounded polymer can prevent penetration new portion of polylactic acid inside the interlamellar space). In addition, free polylactic acid should decrease viscosity of the composition, which enhance its processability.

Therefore, it would have been obvious to a person of ordinary skills in the art to prepare a composition, where polylactic acid exists in both bounded and unbounded forms, since it creates more uniform structure and enhance processability of the composition.

Mitsuru teaches L-polylactic acid and D-polylactic acid and their mixtures (see line 0018).

However, Mitsuru does not specify optical purity of the lactic acid monomers and the ratio between L- and D- polylactic acids in the composition.

Yosimura teaches lactic acid polymer composition, which comprises L-lactic acid optical purity of 95% or more (see line 0085). Lactic acid based polymers of high optical purity is requires to obtain high melting point (which is derives from high degree of crystallinity).

Mitsuru teaches that high rigidity, which provides by highly crystallinic polymer is desirable in his application (see line 0071-0073).

Therefore, it would have been obvious to a person of ordinary skills in the art to use L-and D- polylactic acid of high optical purity in Mitsuru compositions in order to obtain a composition high crystallinity and thus, high rigidity.

Mitsuru does not teach exact ratio between L-and D- polylactic acids (PLLA and PDLA) in his composition.

However, it is known that PDLA and PLLA form a highly regular stereocomplex with increased crystallinity. As evidences by EP 0288041, a blend of L and D polylactic acid with melting point of 243 C (see Claim 1). Note that the above polymer does not have any selective bonding to inorganic material.

In addition, it is noted that the ratio of poly-L-lactic acid to said poly-D-lactic acid in the polylactic acid composition as claimed in amended Claim 1 is from 1:99 wt% to 99:1 wt%, i.e. covering virtually all possible range of the blend.

Therefore, Mitsuru's composition is expected to meet the above claim limitation.

In addition, it would have been obvious to a person of ordinary skills in the art to blend PLLA and PLLA in order to obtain a rigid material with high degree of crystallinity.

### ***Response to Arguments***



Applicant's arguments filed 9/12/2008 have been fully considered but they are not persuasive.

Applicant argues that Mitsuru is directed to binding one or more of poly-L-lactic acid, poly-D-lactic acid, poly-L-lactide and poly-D-lactide, but does not teach or suggest binding one to the exclusion of the other.

Examiner disagrees. Mitsuru teaches binding of one isomer (L or D- polylactic acid) to a clay. Addition of another isomer leads to increased melting point due to stereocrystal formation. For example, EP 0288041 teaches a blend of L and D polylactic acid with melting point of 243 C (see Claim 1). Note that the above polymer does not have any selective bonding to inorganic material.

High melting point is very desirable for articles, where high temperature resistance is needed.

Therefore, it would have been obvious to a person of ordinary skills in the art to modify Mitsuru's polylactic acid/clay composition in order to broaden temperature exploitation range of an article.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY LISTVOYB whose telephone number is (571)272-6105. The examiner can normally be reached on 10am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rabon Sergent/  
Primary Examiner, Art Unit 1796

GL